

## REMARKS

Claims 80-85, 94, 117-126, 128, 133-163 remain in this application. No claims have been cancelled. Claims 80, 124, 133, and 139 have been amended. Claims 144-163 have been added. The amended claims and the added claims are supported by the specification. No new matter has been added. The Applicants respectfully request reconsideration of this application in view of the above amendments and the following remarks.

### 35 U.S.C. §112 Rejection, First Paragraph

The Examiner has rejected claims 80-85, 94, 117-123 and 133-134 under 35 U.S.C §112, first paragraph, for allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the Examiner has stated: *“Terms ‘an overall length ... type III standard’ are recited in claims 80, 133, 139. Basis in disclosure as filed for such limitation is not found.”*

The Applicants respectfully submit that these claimed elements are disclosed in the specification in compliance with all of the requirements of 35 U.S.C. §112, first paragraph. Basis for the claimed elements is provided in the specification at least at pages 55-64 in the context of Figures 22-25. One specific example of basis for these claimed elements is provided in the discussion of Figure 23. Figure 23 shows a card body 374B and a connector housing 374A included in a communications card 374 (page 60, lines 1-2). The connector housing is one example of a receptacle module. The communications card has sliding drawers 376A-C. The communications card has a first configuration in which the drawers are closed and a second position in which the drawers are opened. As stated at page 61, lines 8-12, *“[w]hen the communications card 374 is*

*not being used, all of the sliding drawers 376A-C are closed ... and the overall length of the communications card 374 is preferably and substantially within the PCMCIA Type III standard". See also page 63, lines 14-18.*

Accordingly, the specification is believed to contain support for the claimed elements. The Applicants respectfully request that the Examiner withdraw the rejection of claims 80-85, 94, 117-123 and 133-134.

### **35 U.S.C. §103(a) Rejection**

#### **Aldous 404 in view of Siemon, Hardesty, Clarke and Research Disclosure**

The Examiner has rejected claims 80-85, 94, 117-123 and 133-140 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,183,404, issued to Aldous et al. (hereinafter referred to as "Aldous 404") in view of U.S. Patent No. 4,944,698 issued to Siemon et al. (hereinafter "Siemon"), U.S. Patent No. 4,241,974 issued to Hardesty (hereinafter "Hardesty"), U.S. Patent No. 4,611,875 issued to Clarke et al. (hereinafter "Clarke") and Research Disclosure No. 317 (hereinafter "Research Disclosure"). Without admitting the appropriateness of combining Aldous 404, Siemon, Hardesty, Clark, Ingalsbe and Research Disclosure, Applicants respectfully submit that the present claims are allowable over any combination of Aldous 404, Siemon, Hardesty, Clarke and Research Disclosure.

**Claim 80** recites a device comprising "*a card body*", "*a receptacle module to interface with a communications line, the receptacle module having a portion for removable insertion into the card body to form a unitary module*" and "*an overall length of the unitary module, in a configuration, that is within the PCMCIA Type III standard, and a second overall length of the unitary module, in a second configuration, that is greater than the PCMCIA Type III standard*".

Aldous 404 does not teach or suggest a receptacle module having a portion for removable insertion into the card body to form a unitary module. The Examiner previously stated that it would have been obvious to modify Figure 7 of Aldous 404 by forming parts 52, 54, 50, and 30 (the Applicants note that part 30 is not shown in Figure 7 but is shown in Figure 2) as a single unit that can be plugged into the socket 46 (see Office Action mailed Dec. 4, 2002). The Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Firstly, there is no teaching or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify Figure 7 of Aldous 404 by forming parts 52, 54, 50, and 30 as a single unit that can be plugged into the socket 46.

Secondly, proposed modification still would not meet the claims. The overall length would be significantly greater than the PCMCIA Type III standard length. This is discussed in Aldous 404, at column 7, lines 5-16:

*"The depth of a PCMCIA standard communications card is limited to 5 mm.*

*However the depth of a media connector such as the RJ-type or 8-pin miniature*

*modular plug is approximately 8-12 mm. As a result, an RJ-11 or other modular connector exceeds the depth restrictions imposed by the PCMCIA standards for internal computer components. Direct internal connection of the physical/electrical media connector would necessitate encroaching on a neighboring card space--an approach advocated by some manufacturers, but requiring the sacrifice of space that could be used to provide additional memory capacity”*

Accordingly, the single unit having the RJ-11 socket 36 would plug into the socket 46 and would extend outside the housing of the computer. This is similar to what is shown in Figures 8-9 of Aldous 404. This modification would not satisfy the claim limitation that the overall length of the unitary module, in a configuration, that is substantially within the PCMCIA Type III standard. Applicants respectfully disagree with the Examiner's contention that the length limitation is lacking sufficient precision to overcome the references. If the Examiner persists with rejection on these grounds, then the Applicants respectfully request that the Examiner provide evidence or other basis for the allegation that the length limitation is lacking sufficient precision to overcome the references.

For the foregoing reasons, Applicants submit that the Examiner has failed to establish a prima facie case of obviousness. For at least these reasons, **claim 80** is believed to be allowable. **Claims 81-85, 94, and 117-123** depend from claim 80 and are believed to be allowable therefor, as well as for the recitations independently set forth therein.

**Claims 133 and 139** are believed to be allowable for similar reasons. **Claims 134-138** depend from claim 133 and are believed to be allowable therefor, as well as for the recitations independently set forth therein. Likewise, **claims 140-143** depend from

claim 139 and are believed to be allowable therefor, as well as for the recitations independently set forth therein.

### 35 U.S.C. §102 Rejection - Aldous 404

The Examiner has rejected claims 124-126 under 35 U.S.C. §102(e) as being anticipated by Aldous 404. Applicants respectfully submit that Aldous 404 does not anticipate claim 124, as amended.

As amended, **claim 124** recites a device comprising *“a card body” “a sliding drawer moveably coupled with the card body to open and retract” “a recess positioned in the sliding drawer to receive an RJ-xx series plug when the sliding drawer is open” and “a moveable bottom of the sliding drawer to move downward when the sliding drawer is open to receive the RJ-xx series plug and to shield electrical conductors of the plug from a surrounding environment”*. Any combination of Aldous 404, Siemon, Hardesty, Clark, Ingalsbe and Research Disclosure does not teach or suggest a sliding drawer having a moveable bottom to shield electrical conductors of the plug from a surrounding environment.

With reference to FIG. 20 of Aldous 404, the abutment arm 162, of the pivot arm 154, covers only a portion of the bottom of the plug. As shown by the bottom view of FIG. 21, the contacts of the plug are not shielded from a surrounding environment but instead are exposed to the environment. See also column 20, lines 6-10 of Aldous 404, where it is indicated that only a portion of the electrical contacts remain in the aperture 130. This is not what is claimed in claim 124.

Anticipation under 35 U.S.C. Section 102 requires every element of the claimed invention be identically shown in a single prior art reference. The Federal Circuit has indicated that the standard for measuring lack of novelty by anticipation is strict identity.

*“For a prior art reference to anticipate in terms of 35 U.S.C. Section 102, every element of the claimed invention must be identically shown in a single reference.”* In Re Bond, 910 F.2d 831, 15 USPQ.2d 1566 (Fed. Cir. 1990).

For at least these reasons, **claim 124** is believed to be allowable. Claims 125-128 depend from claim 124 and are believed to be allowable therefor, as well as for the recitations independently set forth therein.

### **Conclusion**

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance. Applicants respectfully request that the rejections be withdrawn and the claims be allowed at the earliest possible date.

### **Request For Telephone Interview**

The Examiner is invited to call Brent E. Vecchia at (303) 740-1980 if there remains any issue with allowance of the case.

### **Request For An Extension Of Time**

The Applicants respectfully petition for an extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. § 1.136(a) should one be necessary. Please charge our Deposit Account No. 02-2666 to cover the necessary fee under 37 C.F.R. § 1.17 for such an extension.

### **Charge Our Deposit Account**

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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